

**IN THE MATTER OF AN OPPOSITION
by Anheuser-Busch, Inc. to
application no. 741,226 for the mark
LITE BEER & Design filed by
Miller Brewing Company**

On November 15, 1993 the applicant Miller Brewing Company filed an application to register the trade-mark LITE BEER & Design, illustrated below,



based on proposed use in Canada for the following wares:

caps, visors, t-shirts, sweatshirts, sweatpants, tank tops, boxer shorts, twill shorts, knit shorts, denim jeans, denim shirts, knit tops, jackets, sweaters, jogging suits, shoes,

picnic coolers,
pens,

beach chairs, beach towels, sunglasses, key rings, bottle openers, metal banks, lighters, belt buckles,

coffee mugs, glassware,

golf towels, golf bags, golf balls and umbrellas.

The subject mark was advertised for opposition purposes in the *Trade-marks Journal* issue dated August 17, 1994 and was formally opposed by Anheuser-Busch, Inc. on January 17, 1995. The registrar forwarded a copy of the statement of opposition to the applicant on March 20, 1995. The applicant responded by filing and serving a counter statement.

The grounds of opposition are pleaded succinctly and are set out in full below.

(A) The applied-for trade-mark LITE BEER & Design is not registrable in that it is, whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is proposed to be used. The statement of wares includes picnic coolers, bottle openers and glassware. Such items clearly relate to beer, including light beer. Furthermore, the other wares listed in the application are also all merchandising items commonly used in the promotion and sale of beer, including light beer. In view of these facts, the applied for trade mark is clearly descriptive or deceptively misdescriptive of the character or quality of the wares listed in the application.

(B) The applied-for trade mark LITE BEER & Design is not distinctive in respect of the wares listed in the application because it does not distinguish nor is it adapted to distinguish the wares of the applicant from the wares of others, including the opponent. Since the wares set out in the application are merchandising items collateral to the sale and promotion of beer, including light beer, the applied for mark LITE BEER & Design cannot be monopolized by or distinguish any one manufacturer, provider or seller of merchandising items related to beer.

The second ground of opposition, alleging non-distinctiveness, relates to the definition of a “distinctive” mark found in Section 2 of the *Trade-marks Act*:

"distinctive", in relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them.

As the subject application is based on proposed use rather than on past use of the mark, it is the second branch of the above definition that is of concern, that is, whether the mark LITE BEER & Design is adapted to distinguish the applicant’s wares.

The opponent’s evidence consists of the affidavits of Todd T. Bailey and Isis E. Caulder, students at law, as well as certified copies of registrations for the following trade-marks: MOLSON LITE & Design, LABATT’S LITE, THE BEER FACTORY, BUD LIGHT, BUD LIGHT & Design (2 marks). The aforementioned registrations cover wares similar to or overlapping with the wares of the subject application. The Bailey and Caulder affidavits establish that various beer producers sell promotional items, similar to or overlapping with the wares of the subject application, featuring their brands of beer including light beer.

With consent of the opponent, the applicant delayed filing its evidence until October 2000. The applicant’s evidence consists of the affidavits(2) of Carol Luciani and Glenda O’Brien, employees of the firm representing the applicant. The Luciani affidavit serves to introduce into evidence copies of several trade-mark registrations including the following:

MAKE IT A BUD LIGHT, B.R.E.W., BUD & Design, MILLER LIGHT, COORS LIGHT & Design, LABATT BLUE LIGHT & Design, and COORS LIGHT. The aforementioned registrations also cover wares similar to or overlapping with the wares of the subject application. Both parties submitted a written argument and both were represented at an oral hearing.

I would first note that the fanciful script employed to form the word portion "lite" in the applicant's mark does very little, if anything, to increase the inherent distinctiveness of the mark which, in its entirety, clearly reads "lite beer." That is, the design features of the mark are intrinsic with the words and the words "lite beer" form the essential part of the trade-mark: see *Canadian Jewish Review Ltd. v. The Registrar of Trade Marks* (1961) 37 C.P.R. 89 (Ex. C.). Accordingly, I will refer to the applicant's mark as LITE BEER.

The material dates with respect to the grounds of opposition pleaded are (i) the date of filing the application, that is, November 15, 1993, with respect to the first ground of opposition pursuant to Section 12(1)(b) of the *Trade-marks Act*: see *Zorti Investments Inc. v Party City Corporation* concerning application no. 766,534, issued by this Board on January 12, 2004, yet unreported, (ii) the date of opposition, in this case January 17, 1995, in respect of the second ground of opposition alleging non-distinctiveness: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and *Clarco Communications Ltd. v. Sassy Publishers Inc.* (1994), 54 C.P.R.(3d) 418 (F.C.T.D.).

There is an initial evidential burden on the opponent in respect of each of the grounds of

opposition pleaded, although the legal onus is on the applicant to establish that its application complies with the provisions of the *Trade-marks Act*. To meet the evidential burden in relation to a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded **B•E•E•R** that the facts alleged to support that issue exist. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.).

Several cases involving the issues at hand have been brought to my attention. In *Molson Breweries v. Labatt Brewing Co.* (2002), 27 C.P.R.(4th) 177 (TMOB) the mark BEER & Design, shown below, was refused for the wares “periodical publication namely, newsletters, booklets.”

The Board found that the mark “would clearly describe a publication about beer and therefore would not distinguish the applicant’s periodical publications from those of others.” The opponent succeeded on the issue of distinctiveness as the Board found that the mark clearly described the subject matter of similar magazines. In *Labatt*, above, the applicant did not file any evidence and was not represented at an oral hearing. Further, the Board accepted the opponent’s submission that the wares specified in the subject application related to the applicant’s main area of trade namely, beer.

In *Anheuser-Busch, Inc. v. Molson Breweries* (1995), 66 C.P.R.(3d) 111 (TMOB) the opponent herein was opposing Molson's proposed use mark B.R.E.W. for wares similar to or overlapping with the wares specified in the instant application. As in the instant case, the opponent was alleging that the applied for mark could not be monopolized by any one manufacturer or seller of brewed beverages on the ground that the trade-mark was clearly descriptive and that the wares specified in the application either related to beer or were merchandising items collateral to the sale and promotion of beer.

After finding that the term "brew" is a colloquial expression for beer and that the applied for mark would be sounded as "brew," Chairman Partington stated as follows, at p.116:

However, no evidence has been furnished by the opponent in support of its submission that the applicant's wares relate to the promotion or sale of beer. Moreover, even had such evidence been adduced, I do not consider the applicant's trade mark B.R.E.W. to be either clearly descriptive or deceptively misdescriptive of "a feature or essential peculiarity of those wares material or intrinsic to their composition" (see *Molson Companies Ltd. v. Carling O'Keefe Breweries of Canada Ltd.* (1981), 55 C.P.R. (2d) 15 at p. 23, [1982] 1 F.C. 275 (T.D.)).

In the instant case I am prepared to infer from the evidence namely, the Bailey and Caulder affidavits, that at all material times the wares specified in the subject application were merchandising items commonly employed by brewers collateral to the sale and promotion of beer. However, that fact by itself does not exclude the possibility that the applied for term LITE BEER may used as a trade-mark in association with the wares specified in the subject application: see, for example, *Anheuser-Busch, Inc. v. John Labatt Ltd.* (2001), 14 C.P.R.(4th) 548 at 562(TMOB). A dual purpose may be served by the mark, that is, to promote the

applicant's beer products and also to identify the opponent as a source of wares specified in the subject application. For example, in *Pizza Pizza Ltd. v. Canada (Registrar of Trade-Marks)* (1998), 26 C.P.R.(3d) 355 (F.C.A.), the Court was concerned with whether a telephone number could be registered as a trade-mark to identify the applicant's food products (pizza, sandwiches and the like) and services (restaurant, delivery). The Court concluded that such a dual purpose was not prohibited, at page 361:

... it is a trade mark and I fail to understand why simply because it also functions as the appellant's telephone number can deprive it of registrability as such a trade mark.

Applying the same test that Chairman Partington applied in the B.R.E.W. case, above, I find that the mark LITE BEER is not clearly descriptive of the wares specified in the subject application. The first ground of opposition based on Section 12(1)(b) of the *Trade-marks Act* is therefore rejected.

Anheuser-Busch, Inc. v. The Upper Canada Brewing Co. Ltd., Dec.17, 1998, is an unreported decision of this Board concerning application no. 754,852 for the mark PURE BEER TASTES BETTER. The application was based on (i) past use of the mark for brewed alcoholic beverages and (ii) proposed use of the mark for wares similar to or overlapping with the wares specified in the instant application. With respect to (i) above, Chairman Partington found that the opponent succeeded under the ground of opposition pursuant to Section 12(1)(b) of the *Trade-marks Act*, that is, the mark was clearly descriptive of brewed alcoholic beverages. The Board continued as follows, at page 7:

The issue, therefore, is whether the fact that applicant's trade-mark is clearly descriptive when applied to its brewed alcoholic beverages precludes it from being capable of distinguishing the applicant's remaining wares from those of others in the marketplace and, in the event that I were to find in favour of the applicant on this issue, whether I should exercise my discretion in rendering a split decision in the facts of this case.

The applicant's intended use of the trade-mark PURE BEER TASTES BETTER on wares other than brewed alcoholic beverages would, in my view, serve to promote its brewed alcoholic beverages. However, such use could arguably serve to distinguish the applicant's wares from the wares of other breweries who are likewise applying their trade-mark to their merchandising products. Moreover, the fact that the applicant's trade-mark is clearly descriptive when applied to brewed alcoholic beverages does not mean that the applicant's trade-mark is likewise descriptive when applied to the remaining wares of the applicant. Nevertheless, since the applicant's remaining wares are intended to promote its brewed alcoholic beverages, the remaining wares and the brewed alcoholic beverages must be considered as being closely related. I am therefore not prepared to render a split decision in the circumstances of the case. I have therefore found in favour of the opponent in respect of this ground of opposition.

Chairman Partington had discretionary jurisdiction to render a split decision: see *Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 482 (F.C.T.D.). As I read the Chairman's reasons for decision in *Upper Canada Brewing*, above, the main purport of the application was to register the mark for brewed alcoholic products. Registration of the mark for promotional wares was to serve an ancillary purpose, that is, to advertise the applicant's beer product. As the main purpose for the application was refused, Chairman Partington exercised his discretion to refrain from permitting the ancillary part of the application to proceed. The case before me is distinguishable from *Upper Canada Brewing*, above, as the instant application does not concern both primary wares (that is, beer) and ancillary wares (that is, merchandising items) and therefore I am not in a position to exercise similar discretion.

With respect to the second ground of opposition, the opponent argues as follows at paragraph 30 of its written argument:

30. In *Anheuser-Busch, Inc. V. Upper Canada Brewing Co. Ltd.* (supra), it was held that the applicant's use of its trade-mark on wares other than brewed alcoholic beverages would serve to promote its brewed alcoholic beverages. Since that is the case herein and since the term is generic and descriptive, it cannot distinguish such wares of any one brewer from those of any other brewer. As mentioned above, the instant case is distinguishable from the B.R.E.W. case evidenced by the applicant in two ways. Firstly, the term at issue here is LITE BEER (or LIGHT BEER) the use of which is governed by federal legislation. Accordingly, the term cannot distinguish the wares of any brewer, whether beer or ancillary items, from those of others. Any brewer of light beer must be able to use the term LIGHT BEER or its phonetic equivalent LITE BEER with beer and with ancillary goods. The opponent and the applicant have both evidenced that this is already a common practice. Thus, the trade mark, which has no additional distinctive design elements, is not distinctive and was not adapted to distinguish the applicant's wares from those of others.

From my review of the evidence, I do not find that it is a common practice for brewers to use the term LITE BEER or LIGHT BEER by itself in association with beer or featured on promotional wares. Not surprisingly, the evidence does show that it is common for brewers use the terms “lite” or its phonetic equivalent “light” and/or “beer” together with other indicia referring to the brewer such as LABATT, COORS, BUDWEISER or BUD. I agree with the applicant that the applied for mark effectively has no distinctive design elements as the design feature is integral to the letters comprising the word LITE. Further, as alluded to in paragraph 30, above, Part B - Foods - Division 1 of the *Regulations* of the *Food and Drugs Act* provides as follows:

In other words, if a trader intends to generally promote beer products falling within Item 2 of the Table above, or to promote its own brand of an Item 2 beer product, then the trader is obliged to use the term “light beer.” Given that the applied for mark LITE BEER is the phonetic equivalent of the term “light beer,” that it is obligatory for brewers who wish to promote Item 2 beer products to use the term “light beer” and that it is common in the trade to promote or advertise beer products on wares such as those specified in the subject application, I find that the applied for mark LITE BEER is not adapted to distinguish the applicant’s wares specified in the subject application.

The opponent therefore succeeds on the second ground of opposition. The subject application is refused.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 25th DAY OF NOVEMBER, 2004.

Myer Herzig,
Member,
Trade-marks Opposition Board